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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/910,655	07/20/2001	John E. Liebendorfer	0111210.00129US1	2619
24395	7590	11/17/2006	EXAMINER KING, ANITA M	
WILMER CUTLER PICKERING HALE AND DORR LLP 1875 PENNSYLVANIA AVE., NW WASHINGTON, DC 20004			ART UNIT 3632	PAPER NUMBER

DATE MAILED: 11/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/910,655

Applicant(s)

LIEBENDORFER, JOHN E.

Examiner

Anita M. King

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3,4,6-10,13-23,31,32,36-38 and 41-49 is/are pending in the application.
- 4a) Of the above claim(s) 24-30 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 10 and 13-23 is/are allowed.
- 6) ☒ Claim(s) 1,3,4,31,32,36-38 and 41-49 is/are rejected.
- 7) ☒ Claim(s) 6-9 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 July 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>8/16/06</u> . | 6) <input type="checkbox"/> Other: _____  |

This is a non-final office action for application number 09/910,655, System for Removably and Adjustably Mounting a Device on a Surface, filed on July 20, 2001.

***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114 was filed in this application after appeal to the Board of Patent Appeals and Interferences, but prior to a decision on the appeal. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on August 16, 2006 has been entered.

***Election/Restrictions***

Claims 24-30 have withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on August 26, 2002.

***Drawings***

The drawings are objected to under 37 CFR 1.83(a) because they fail to show the limitations of claim 10, i.e., a means for variably positioning the at least one dual track rail on the at least one keeper as described in the specification. Any structural detail that is essential for a proper understanding of the disclosed invention should be

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shown in the drawing. MPEP § 608.02(d). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement-drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

#### ***Cancellation of Claims***

Claims 2, 5, 11, 12, 33-35, 39, and 40 have been canceled per applicant's request.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 38 and 41-49 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Neither the specification nor the drawings teach the limitation of the one or more clamps including a means variably positioning the clamp in the hollow chamber and for positioning the at least one keeper in the hollow chamber of the track rail.

Claim 36 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a clamp formed as a duct having at least two opposing flanges substantially parallel to one another (Fig. 10), does not reasonably provide enablement for a clamp formed as a duct having a leg having a base, a descending member monolithically extending from the base, and an ascending member monolithically extending from the base in a direction substantially opposite the direction of the descending member. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims. The clamps in Figs. 10 and 11 are different embodiments and only the clamp in Fig. 10 is formed as a duct.

***Claim Rejections - 35 USC § 102***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 3, and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 3,529,274 to Routh. Routh discloses a system for removably and adjustably mounting a device on a surface, comprising: a rail (17) formed with at least two tracks (34, 46); wherein the rail is formed with a body having a proximal end, a distal end, and a hollow chamber (33) therebetween; wherein the rail is removably mountable on a footing grid; wherein the at least two tracks include a channel extending the length of the rail; a plurality of keepers (76) on which to mount the rail; one or more clamps (68) for connecting the system to the surface; wherein the channel in the at least two tracks is formed with a slot extending the length of the rail; and wherein the slot in one of the at least two tracks is formed at substantially a right angle to the slot in any other of the at least two tracks.

Claims 31, 32, and 37 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 3,778,175 to Zimmer. Zimmer discloses a system comprising: a rail (2') formed with at least two tracks (16' and 17); wherein the at least two tracks include a slot formed at substantially a right angle to the slot in any other of the at least two tracks; wherein the rail is formed with a body having a proximal end, a distal end, and a hollow chamber therebetween; one or more clamps (3); wherein the one or more clamps is formed as a duct with at least two opposing flanges (25) that are substantially parallel to one another; wherein the at least two tracks includes a channel extending the

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length of the rail; and wherein the one or more clamps include means (22-24) for connecting.

### ***Allowable Subject Matter***

Claims 6-9 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 10 and 13-23 are allowed.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent 4,541,627 to MacLean et al.

U.S. Patent 5,979,119 to Trafton

U.S. Patent 6,615,564 to Lutrario et al.


U.S. Patent 6,796,680 to Showers et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anita M. King whose telephone number is (571) 272-6817. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl Friedman can be reached on (571) 272-6842. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Anita M. King  
Primary Examiner  
Art Unit 3632

November 13, 2006